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PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2172

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Susumu HONMA et al.

Group Art Unit: 2172

Application No.: 09/836,271

Examiner: M. Hamilton

Filed: April 18, 2001

Docket No.: 109295

For: DATA INPUT FORM GENERATION SYSTEM, DATA INPUT FORM
GENERATION METHOD, AND COMPUTER-READABLE RECORDING MEDIUM

REQUEST FOR RECONSIDERATION

RECEIVED

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOV 14 2003
Technology Center 2100

Sir:

In reply to the September 11, 2003 Office Action, reconsideration of the application is respectfully requested in light of the following remarks.

Claims 1-15 are pending.

The Office Action rejects claims 1-15 under 35 USC §103(a) over U.S. Patent No. 6,247,018 to Rheume in view of U.S. Patent 5,930,799 to Tamano et al. (hereinafter, "Tamano"). This rejection is respectfully traversed.

As clearly stated in the preamble of claim 1, claims 1-5 are clearly directed to a "data input form generation system." Rheume is clearly not directed to a "data input form generation system."

Rheaume does not disclose or suggest generating data input forms. Instead, Rheaume discloses extracting data from HTML web pages, regardless of the form in which the data is presented in those web pages. Rheaume then stores the extracted data in the form of a database "so that the data can be manipulated in the particular manner desired by the user, thus freeing the user from the format provided by the web site" - see col. 1, lines 45-48.

In col. 2, lines 35-38, Rheaume discloses that "[A]s a result of the processing of the data in the HTML table, the underlying data in the HTML table can be identified and extracted for including in a database representing the underlying data." (emphasis added)

Rheaume does not disclose that the web pages on which its invention operates contain a data input form, i.e., a form in which data can be input. Accordingly, Rheaume does not disclose a "data form acceptance means for accepting input of a data input form," as recited in claims 1-5.

Rheaume does not extract a table from the data input form accepted by the data input form data acceptance means at least because Rheaume does not accept a data input form. Additionally, Rheaume explicitly discloses that it extracts underlying data from tables and puts that data in relational database tables. This is not extracting a table, and is not what is recited in independent claims 1, 6, and 11.

Thus, contrary to the assertions made in the Office Action, Rheaume does not disclose a number of positively recited features of claims 1-15.

In the "Response to Arguments" section of the Office Action, page 3, the Office Action states:

Examiner therefore holds that Rheaume's processing of the HTML page and creating a relational database is equivalent to applicants claimed "table extraction means for extracting the table from the data input form accepted by the data input form acceptance means" and "database defining means for defining a database on the table extracted by the table extraction means,".

Applicants respectfully submit that the doctrine of equivalents has nothing to do with patentability and whether what is being claimed is disclosed by Rheaume. The doctrine of equivalents only applies to patent infringement, a wholly different issue than patentability over applied art. Moreover, the asserted equivalence has not been demonstrated in any way to be relevant to the rejection, nor has the nature of the alleged equivalence, nor the degree of equivalence been stated. In effect, Applicants have not been presented with a cogent reason why this "equivalent" holding has been made or what it has to do with the outstanding rejection of the claims.

The Office Action then unequivocally admits that Rheaume does not explicitly disclose "data input form generation means for generating a database-related data input form related with the database by relating the table included in the data input form accepted by the data input form acceptance means with the database defined by the database defining means."

In an attempt to remedy this admitted deficiency, the Office Action cites and applies Tamano. In this regard, the Examiner "holds" that Tamano relates the table included in the data input form accepted by the data input form acceptance means with the database defined by the database defining means.

Applicants respectfully disagree. Tomano does not disclose that the data input form includes a table. Instead, Tomano creates a table in the database it creates. There is a big difference between inputting a data input form that includes a table and inputting a form and creating a database table from the data input form.

Applicants also note that Tomano differs significantly from Rheaume. Tomano pertains to a case record database structured as set forth in col. 2, lines 5-36.

Rheaume has no need nor use for a case record database. Rheaume is directed to "automatically processing" of a web page or ASCII file to treat the file as a database.

Rheaume does not generate a user input image. On the other hand, Tomano needs user input to generate image information and does generate a user input image. Moreover, unlike Rheaume, Tomano does not perform "automatic processing" to generate a database. Tomano requires input from a user in several steps to create a database and, thus, does not perform "automatic processing" to generate a database.

Additionally, Applicants respectfully submit that Tamano does not disclose "data input form generation means for generating a database-related data input form related with the database by relating the table included in the data input form accepted by the data input form acceptance means with the database defined by the database defining means," as recited in independent claims 1, 6 and 11. As noted above, Tamano does not disclose a table included in the data input form accepted by the data input form acceptance means with the database defined by the database defining means. Instead, Tamano relates data in the form that is input to its system with the database it defines.

Applicants respectfully submit that both the Rheaume and Tomano references are deficient with respect to features recited in the independent claims, as set forth above. Accordingly, even if these references were properly combined, they would not achieve the claimed invention.

Furthermore, Applicants do not believe that one of ordinary skill in the art would have been motivated to combine the references as asserted in the Office Action. The asserted motivation for combining these two references is to "allow a user [to] quickly input new value into the database."

The Office Action never explains what the "new value" is or why Rheaume would not already add any "new value" using its disclosed "automatic processing" without any modification. Moreover, as discussed above, Rheaume has no need nor use for a case record database. Further, as discussed above, Tomano does not perform "automatic processing" to

generate a database, but requires input from a user in several steps to create a database.

Rheaume, the primary reference, discloses a method for automatically processing a file.

Thus, Rheaume presumably performs its method quickly. Additionally, Rheaume shows no need for any modification. Furthermore, if the added feature admittedly not in Rheaume is added to Rheaume, the execution of such an added feature would require additional time, thus teaching away from the alleged motivation, i.e., to quickly input new value into the database.

The asserted motivation, i.e., to allow a user to quickly input new value into the database," is a general statement of what appears to be an inherent quality of any computerized database system and is not the specific, detailed evidence needed to provide proper motivation to modify one reference in view of another reference, especially where the two references differ so fundamentally. A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617.

Furthermore, as discussed in detail above, these two references have fundamental differences. One would not be motivated to combine these two references absent Applicants'

disclosure being used as a template to guide them. However, this is improper hindsight reconstruction of the claimed invention.

Lastly, the Office Action indicates that Applicants do not clearly point out the patentability that they think that the claims present in view of the state of the art disclosed by the references cited. Applicants respectfully disagree.

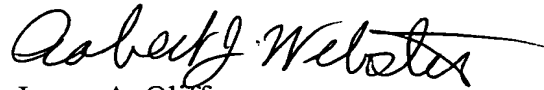
During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a prima facie case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability vel non is then determined on the entirety of the record, by a preponderance of evidence and weight of argument.

For the detailed, specific reasons stated above, Applicants submit that the PTO has not made out a prima facie case of unpatentability of the claimed invention. Under these circumstances, the burden has not shifted to Applicants to come forward with additional arguments or evidence to support patentability. Nevertheless, Applicants' arguments above not only demonstrate that the Office Action fails to make out a prima facie case of unpatentability of the claimed invention, they also support patentability of the claimed invention over the cited references.

For the aforementioned reasons, Applicants respectfully submit that claims 1-15 are not rendered obvious by either Rheume or Tamano, alone or in combination. Therefore, the rejection of claims 1-15 under 35 USC §103(a) over Rheume in view of Tamano is improper and should be withdrawn.

Should the Examiner believe that anything else is needed to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:RJW/sxb

Date: November 12, 2003

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